

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Takeo Katsuda

Application No.: 09/880,039

Filed: June 14, 2001

For: APPARATUS, PORTABLE  
TERMINAL UNIT, AND SYSTEM  
FOR CONTROLLING E-MAIL,  
AND ITS METHOD, COMPUTER-  
READABLE RECORDING  
MEDIUM AND PROGRAM  
PRODUCT FOR PROCESSING  
E-MAIL



Group Art Unit: 2145

Examiner: THOMAS DUONG

Appeal No.: \_\_\_\_\_

APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated December 8, 2006 finally rejecting claims 14-31 and 37-47, which are reproduced as the Claims Appendix of this brief.

- ☐ A check covering the ☐ \$ 250 ☐ \$ 500 Government fee is filed herewith.
- ☒ Charge ☐ \$ 250 ☒ \$ 500 to Credit Card. Form PTO-2038 is attached.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

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I. Real Party in Interest

The present application is assigned to Minolta Co., Ltd.. Minolta Co., Ltd. is the real party in interest.

II. Related Appeals and Interferences

The Appellant's legal representative, or assignee, does not know of any other prior or pending appeals, interferences, or judicial procedures, which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application contains claims 1-47. Claims 1-13 and 32-36 have been canceled. Claims 14-31 and 37-47 are pending, and stand rejected. This appeal is directed to each of the rejections of claims 14-31 and 37-47.

IV. Status of Amendments

An Amendment is being filed with this Appeal Brief. Claims 41 and 43 are being amended to cure a lack of antecedent basis. The amendments do not affect the Appellants' substantive arguments against the rejections. The claims appearing in the accompanying Appendix incorporate these amendment.

V. Summary of Claimed Subject Matter

The independent claims are generally directed to an e-mail controlling apparatus and e-mail controlling system, an e-mail processing method, a computer readable medium and a program product and an e-mail controlling apparatus.

Appellant's Figure 3 is a conceptual diagram for describing the various functions performed by the claimed embodiments. As described at paragraphs [0045]-[0054], an e-mail receiving module 121 and an e-mail sending module 122 are software modules for, respectively, receiving and sending e-mails according to a conventional protocol similar to an existing mail server. An e-mail analysis module 123 is a software module for determining whether e-mail has been received from another mail server, has any attachments, and for extracting the attached files. In

addition, the e-mail analysis module 123 extracts the instruction parts of telephone numbers and IP addresses contained in the e-mail. An e-mail editing module 124 prepares a receipt notice e-mail. Specifically, the receipt notice e-mail is prepared by removing the attachment file portion from the received e-mail, and adding the fact that the attachment file portion is removed as well as the name and type of the attachment file that has been removed (paragraph [0050]). A format or type conversion module 125 converts the e-mail into a format that can be output by a selected image output device. Image output devices 950, 960 and 970 are shown in Figure 1.

Also disclosed is a portable telephone position acquisition module 126 for acquiring the current location of a portable telephone for receiving e-mail via the network and the telephone network. A location information registration module 127 registers and stores the location information of multiple image output devices by the type of device (paragraph [0052]). An output search module 128 selects the image output device to which the entire e-mail received by the mail server 100 and/or the data that corresponds to the attachment file is output.

A mapping of each of the independent claims to the disclosure is set forth in the following claim charts.

Claim	Disclosure
14. An E-mail controlling apparatus comprising:	Paragraph [0044], Mail Server 100, Fig. 2
an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;	The software module described in Paragraph [0045] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;	The software module described in Paragraph [0047] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail	The e-mail sending software module described in Paragraph [0045] as

prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;	executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]; Fig. 3
an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;	Mail server 100, Fig. 1, Step S205, Fig. 5 and Paragraph [0062]; Fig. 3
a converting device converting the attachment file portion into data of a format acceptable to the image output device; and	The software module described in Paragraph [0048] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.	The software module described in Paragraphs [0045], [0048] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]; Fig. 5
15. An E-mail controlling system comprising:	Figs. 1-3, and 5, Paragraphs [0051], [0053] and [0056].
an E-mail receiving device receiving E-mail addressed to a portable terminal unit;	The software module described in Paragraph [0045] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051] and Paragraph [0060]
an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device;	The software module described in Paragraph [0045] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051] and Paragraph [0062]
an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit;	The e-mail sending software module described in Paragraph [0045] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051] and Paragraph [0062]
a location information acquiring device acquiring	The software module described in Paragraph

location information of said portable terminal unit;	[0049] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051];
a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device;	Mail server 100, Fig. 2 and 3; Paragraphs [0089], [0098]
a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and	Mail server 100, Fig. 2 and 3; Paragraph [0095]
a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device.	Mail server 100, Figs. 2 and 3; Paragraph [0096]
31. An E-mail controlling system comprising:	Figs. 1-3, and 5, Paragraphs [0051], [0053] and [0056].
an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;	Fig 8, Paragraph [0071]
an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;	Mail server 100, Fig. 2 Paragraph [0074]
an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;	Mail server 100, Fig. 2 Paragraphs [0053] and [0058]
an instruction receiving device receiving an E-mail including an instruction specifying one of multiple image output devices;	Mail server 100, Fig. 2; Paragraphs [0053] and [0065]

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and	Mail server 100, Fig. 2; Paragraphs [0051], [0056] and [0066]
a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.	Mail server 100, Fig. 2; Paragraph [0066]
37. An E-mail controlling system comprising:	Figs. 1-3, and 5, Paragraphs [0051], [0053] and [0056].
an E-mail controlling apparatus;	Mail server 100, Fig. 1, Paragraph [0056]
a portable terminal unit receiving E-mail from said E-mail controlling apparatus; and	Portable telephone 200, Fig. 1, Paragraph [0056]
an image output device capable of receiving data from said E-mail controlling apparatus;	Printer 960, Fig. 1
said E-mail controlling apparatus including: an E-mail receiving device receiving E-mail addressed to said portable terminal unit;	Mail server 100, Fig. 1 Paragraphs [0046] and [0053]
an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device;	Mail server 100, Fig. 1 Paragraph [0053]
an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit;	Mail server 100, Fig. 1 Paragraph [0053]
a location information acquiring device acquiring location information of said portable terminal unit;	Mail server 100, Fig. 1 Paragraphs [0052] and [0063]
a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said position acquiring device;	Mail server 100, Fig. 1, Paragraphs [0089] and [0098]
a notifying device that sends an E-mail to said portable terminal unit containing a notification of the	Mail server 100, Fig. 1, Paragraph [0095]

image output device selected by said selecting device; and	
a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device;	Mail server 100, Fig. 1, Paragraph [0096]
said image output device outputting the content of the E-mail based on the data received from said E-mail controlling apparatus.	Mail server 100, Fig. 1, Paragraph [0098]
38. An E-mail processing method comprising the steps of:	Figs. 6 and 7
receiving E-mail addressed to a certain destination;	Figs. 6 and 8, Paragraph [0070]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said destination;	Fig. 7, step S311, Paragraph [0090]
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, step S319, Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig 7, S318 Paragraph [0096]
39. An E-mail processing method comprising the steps of:	Figs. 6 and 7
receiving E-mail addressed to a portable terminal unit;	Figs 6 and 8 Paragraph [0070]
preparing receipt notice E-mail based on the	Paragraph [0074]

received E-mail;	
transmitting said receipt notice E-mail to said portable terminal unit;	Fig. 7, step S311, Paragraph [0090]
acquiring location information of said portable terminal unit;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and	Fig. 7, step S319, Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, step S318, Paragraph [0096]
40. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:	Figs. 6 and 7, Paragraph [0145]
receiving E-mail addressed to a certain destination;	Figs. 6 and 8, Paragraph [0070]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said destination;	Fig. 7, S311 Paragraph [0090]
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, S306 Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, S319 Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, S318 Paragraph [0096]



41. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:	Figs. 6 and 7, Paragraph [0145]
receiving E-mail addressed to a portable terminal unit;	Figs. 6 and 8, Paragraph [0070]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said portable terminal unit;	Fig. 7, step S311, Paragraph [0090]
acquiring location information of said portable terminal unit;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and	Fig. 7, step S319, Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig 7, step S318, Paragraph [0096]
42. A program product comprising:	Paragraph [0145]
a computer-readable medium; and	Paragraph [0145]
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of: receiving E-mail addressed to a certain destination;	Figs. 6 and 7, Paragraph [0145]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said	Fig. 7, step S311 Paragraph [0090]

destination;	
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, step S319 Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, step S318, Paragraph [0096]
43. A program product comprising:	Paragraph [0145]
a computer-readable medium; and	Paragraph [0145]
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of: receiving E-mail addressed to a portable terminal unit;	Figs. 6 and 7, Paragraph [0145]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said portable terminal unit;	Fig. 7, step S311, Paragraph [0090]
acquiring location information of said portable terminal unit;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said portable unit containing a notification of the selected image output device; and	Fig. 7, step S319, Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, step S318, Paragraph [0096]

44. An E-mail controlling apparatus comprising:	Mail server 100, Figs. 1 and 2
a communication interface for sending and receiving E-mails;	Fig. 2, element 170, Paragraphs [0040] - [0042], [0044], and [0046]
a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.	Fig. 2, element 110 Paragraphs [0044], [0045], and [0054]

#### VI. Grounds of Rejection to be Reviewed on Appeal

Claims 14-31 and 37-47 were rejected under 35 U.S.C. § 102(e) as being anticipated by Miller et al. (US006421707B1).

Claims 14-31 and 37-46 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. Claim 47 was rejected under 35 USC § 103(a) as being unpatentable over Miller and Theimer further in view of Glorikian.

#### VII. Argument

##### A. Rejection Under 35 USC § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

For purposes of this Brief, the independent claims can be divided into two groups, each of which recites at least one element that is not disclosed in the references.

1. Claims 15 and 37-44

Independent claim 15 recites a device that selects one of multiple image output devices and "a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device." Thus, an email is sent to the portable terminal, and this email identifies an image output device on which data is to be output. Independent claims 37-44 recite a similar notifying feature as independent claim 15.

In making the rejection of claim 15 in the Final Office Action, the Examiner asserts that the claimed notifying device that sends an E-mail to the portable terminal containing a notification of the image output device selected by the selecting device is disclosed by the Miller patent at column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46.

The Examiner goes on to explain at page 5, second bullet point, that the Miller patent teaches an environment where e-mail addressed to a mobile subscriber is received at the service controller, a receipt notification is selectively generated and delivered to the addressee and finally the intended e-mail is displayed to the subscriber or output to a device such as a facsimile. The Examiner then quotes a substantial portion of column 3, lines 33-38.

After carefully considering the Examiner's arguments on pages 24-28 of the final Office Action, the characterization of the Miller system, the language quoted from Column 3 of the Miller patent, and the other cited columns and lines, the Appellant was unable to find the claimed feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device in the Miller patent.

The system described in the Miller patent merely sends a receipt notification, nothing more. For example, column 1, lines 47-58, in particular, lines 54-58 state "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber,

according to a delivery indication sent by the subscriber to the network." (Emphasis added). There is no mention of an e-mail containing a notification of the image output device selected by the selecting device being sent to the portable terminal unit.

Column 2, lines 52-64 describe subsystems and delivery systems that are suitable for implementing the system architecture. Column 5, lines 35-49 describes the process of pressing the content soft key with reference to Figure 4(i).

Column 6, lines 14-19 describe the hypothetical user entering a destination fax number to which a graphics file is to be sent.

Finally, column 9, lines 40-46 discuss that filtering and forwarding rules are flexible, and permit filtering and forwarding of mail messages in any manner capable of being specified as a rule. Again, there is no disclosure or suggestion of sending an e-mail containing a notification of the image output device selected by the selecting device in any of the above citations or in column 3, lines 33-38 of the Miller patent.

In the Advisory Action dated April 2, 2007, the Examiner based his rebuttal on the passage of the Miller patent at column 1, lines 52-58, which states:

Upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network. (emphasis added)

As explained above, there is no mention in this passage of an e-mail containing a notification of the image output device being sent to the portable terminal unit. The Miller patent describes a notification acknowledging receipt of a message and delivery of the message to an output device indicated by the subscriber.

In the Advisory Action, the Examiner points again to Figures 4(j), 4(n), 4(q) and 4(t) of the Miller patent, as disclosing the claimed features. Each of these figures merely presents choices, i.e., a menu, to the subscriber so the subscriber can choose how to receive the attachments.

First, neither the Office Action nor the Advisory Action establishes that the described menu is provided by means of an email that is sent to the handset of the

subscriber. Rather, the logical assumption is that the menu is displayed by software within the handset.

Second, this menu does not provide notification of an image output device that has been selected by a selecting device and sent to the handset. Instead, it is the mechanism by which the user makes a selection, which is then transmitted from the handset.

In the context of the Miller patent, there is no reason to send an email to the subscriber containing a notification of the image output device selected by the selecting device. In particular, the subscriber uses the menu of Figure 4(j) to choose an image output device X. As such, why would it be necessary to send the subscriber an E-mail informing the subscriber that he or she just chose image output device X?

At page 3, the end of numbered paragraph 2 of the Advisory Action, the Examiner concisely describes the teaching of Miller:

Hence, Miller teaches of the subscriber confirming with the system in using SMS as the selected delivery method via a display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery method to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.

This statement does not address the claimed subject matter. The fact that the subscriber chooses to use SMS, i.e., a messaging service, as a “delivery method” has nothing to do with providing notification of a selected image output device on which data of a received email is to be output. How the user chooses to receive a message is entirely distinct from informing the user of the device on which data is to be output.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claim 15. Since each of claims 37-44 also recites this notification feature, the Office action has not established the requisite support for the rejection, and the rejection of claims 15 and 37-44 should be reversed.

2. Claims 14 and 31

Independent claims 14 and 31 recite, in combination with other features, an E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices.

Page 11 of the final Office Action states the Examiner's rationale for rejecting claims 14 and 31. The Examiner asserts that the same citations used to reject the notifying device recited in claim 15, that is, column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46, disclose the E-mail transmitting device of claims 14 and 31.

However, as in the rejection of claim 15, the claimed feature of an E-mail identifying multiple prospective image output devices is not disclosed. None of the citations describe the claimed step of transmitting an E-mail identifying multiple prospective image output devices, only the selective sending of a receipt notification.

The system of Miller does not provide a E-mail identifying multiple prospective image output devices as recited in independent claim 14. As stated in column 1, lines 54-58 of the Miller patent, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (Emphasis added). This is not the same as the claimed feature.

Independent claim 31 recites a similar E-mail transmitting device as independent claim 14. The Miller patent does not disclose all of the features recited in independent claims 14 and 31.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claims 14 and 31. The rejection should be reversed.

3. Claim 44

Independent claim 44 recites a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail

and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination. (Emphasis added). The cited portions of the Miller patent, i.e., column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46, do not disclose a processor for generating at least one E-mail containing information on at least one output device to which at least part of the E-mail is to be output as recited in independent claim 44.

In the Advisory Action, the Examiner attempts to rebut the Appellant's arguments with a similar argument as presented with respect to claim 15 by referring to Miller's Figures 4(j), 4(n), 4(q) and 4(t). As stated by the Examiner, Miller teaches a system presenting the subscriber with the system selected outputting means.

However, the Office Action does not establish that this menu is presented by means of an email that is sent to the handset of the subscriber. Rather, the logical assumption is that the menu is displayed by software within the handset.

Second, this menu does not provide an email identifying multiple prospective image output devices to the handset. Instead, it is the mechanism by which the user makes a selection, which is then transmitted from the handset.

The Miller patent does not disclose all of the features recited in independent claim 44.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claim 44. The rejection should be reversed.

B. Rejections under 35 USC §103

1. Claims 14-31 and 37-46

Claims 14-31 and 37-46 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. All the features of the claims have not been identified or explained in a manner that makes the claimed features obvious to one of ordinary skill in the art.



One criterion for establishing a prima facie case of obviousness is that all features of the claimed invention be taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As discussed previously, there has been no showing that Miller patent discloses or suggests sending an e-mail containing a notification or an E-mail identifying multiple prospective image output devices, as recited in the independent claims.

As stated at page 17 of the final Office Action, the Examiner is relying on the Thiemer patent for its alleged disclosure of the claimed features of a location information acquiring device and a selecting device. However, the Office Action does not show that the Thiemer patent overcomes the deficiencies of the Miller patent outlined above.

The Examiner has not provided a citation in the Thiemer patent that discloses the claimed features of an E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices (claims 14 and 31); a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device (claims 15, 37-42); or a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination (claim 44). (Emphasis added)

Neither the Miller patent nor the Thiemer patent, either individually or in combination, disclose all of the features recited in the independent claims and those that depend therefrom. Appellant respectfully requests that the rejection of claims 14-31 and 37-46 be reversed.

## 2. Claim 47

Claim 47 was rejected under 35 U.S.C. §103(a) over the combination of the Miller and Thiemer patents, further in view of the Glorikian patent.

The Glorikian patent, cited in the rejection of claim 47, does not overcome the deficiencies of the Miller and Theimer patents with respect to the feature claimed in parent claim 15 of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by the selecting device. Therefore, the Glorikian, Miller and Theimer patents, either individually or in combination, do not disclose all of the features recited in dependent claim 47.

C. In Conclusion

The final Office Action does not meet the burden of showing that the references disclose every element recited in the claims, as required to support a rejection under 35 USC 102 or 103. The rejections do not meet the requirements of the statutes, and should be reversed.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

None.


X. Related Proceedings Appendix

None.

Respectfully submitted,

BUCHANAN INGERSOLL AND ROONEY PC

Date July 23, 2007

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## **VIII. CLAIMS APPENDIX**

### **The Appealed Claims**

Claim 14. An E-mail controlling apparatus comprising:

an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;

an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

Claim 15. An E-mail controlling system comprising:

an E-mail receiving device receiving E-mail addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device;

an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit;

a location information acquiring device acquiring location information of said portable terminal unit;

a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device;

a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and

a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device.

Claim 16. The E-mail controlling system according to claim 15 wherein said E-mail preparing device prepares the receipt notice E-mail based on the content of a main text portion of the E-mail received by the E-mail receiving device.

Claim 17. The E-mail controlling system according to claim 15 wherein said E-mail preparing device prepares the receipt notice E-mail by removing an attachment file portion of the E-mail received by the E-mail receiving device.

Claim 18. The E-mail controlling system according to claim 17 wherein said data transmitting device transmits data corresponding to the attachment file portion of the E-mail received by the E-mail receiving device.

Claim 19. The E-mail controlling system according to claim 18 further comprising a converting device converting the attachment file portion of the E-mail received by the E-mail receiving device into data of a format acceptable to the image output device; wherein,

said data transmitting device transmits the data after the conversion by said converting device.

Claim 20. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits data corresponding to an attachment file portion of the E-mail received by the E-mail receiving device.

Claim 21. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data corresponding to the entire portion of the E-mail received by the E-mail receiving device.

Claim 22. The E-mail controlling system according to claim 15 wherein said selecting device selects image output devices within a certain distance from said portable terminal unit.

Claim 23. The E-mail controlling system according to claim 15 wherein said selecting device selects an image output device closest to said portable terminal unit.

Claim 24. The E-mail controlling system according to claim 15 wherein said selecting device includes:

a memory device storing location information of multiple image output devices; and

a search device searching image output devices suitable for the location information acquired by said location information acquiring device from multiple image output devices whose location information is stored in said memory device.

Claim 25. The E-mail controlling system according to claim 15 wherein said selecting device includes:

a list preparing device preparing a list of image output devices within a certain distance from said portable terminal unit;

a list transmitting device transmitting the list prepared by said list preparing device to said portable terminal unit; and

a selection instruction receiving device receiving an instruction specifying one of the image output devices in the list.

Claim 26. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data to an image output device specified by an IP address.

Claim 27. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits the data to an image output device specified by a telephone number.



Claim 28. The E-mail controlling system according to claim 15 wherein communication between said E-mail transmitting device and said portable terminal unit is conducted indirectly via another E-mail controlling system.

Claim 29. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a display selected by the selecting device.

Claim 30. The E-mail controlling system according to claim 15 wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a printer.

Claim 31. An E-mail controlling system comprising:

an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;

an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

Claim 37. An E-mail controlling system comprising:

an E-mail controlling apparatus;

a portable terminal unit receiving E-mail from said E-mail controlling apparatus; and an image output device capable of receiving data from said E-mail controlling apparatus;

said E-mail controlling apparatus including: an E-mail receiving device receiving E-mail addressed to said portable terminal unit; an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device; an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit; a location information acquiring device acquiring location information of said portable terminal unit; a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said position acquiring device; a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device;

said image output device outputting the content of the E-mail based on the data received from said E-mail controlling apparatus.

Claim 38. An E-mail processing method comprising the steps of:

- receiving E-mail addressed to a certain destination;
- preparing receipt notice E-mail based on the received E-mail;
- transmitting said receipt notice E-mail to said destination;
- acquiring location information of said destination;
- selecting one of multiple image output devices on the basis of the location information of said destination acquired;
- sending an E-mail to said destination containing a notification of the selected image output device; and
- transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 39. An E-mail processing method comprising the steps of:

- receiving E-mail addressed to a portable terminal unit;
- preparing receipt notice E-mail based on the received E-mail;
- transmitting said receipt notice E-mail to said portable terminal unit;
- acquiring location information of said portable terminal unit;
- selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;
- sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and
- transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 40. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:

- receiving E-mail addressed to a certain destination;
- preparing receipt notice E-mail based on the received E-mail;
- transmitting said receipt notice E-mail to said destination;
- acquiring location information of said destination;
- selecting one of multiple image output devices on the basis of the location information of said destination acquired;
- sending an E-mail to said destination containing a notification of the selected image output device; and
- transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 41. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:

- receiving E-mail addressed to a portable terminal unit;
- preparing receipt notice E-mail based on the received E-mail ;
- transmitting said receipt notice E-mail to said portable terminal unit;
- acquiring location information of said portable terminal unit;
- selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;
- sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and

transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 42. A program product comprising:  
a computer-readable medium; and  
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of:  
receiving E-mail addressed to a certain destination;  
preparing receipt notice E-mail based on the received E-mail;  
transmitting said receipt notice E-mail to said destination;  
acquiring location information of said destination;  
selecting one of multiple image output devices on the basis of the location information of said destination acquired;  
sending an E-mail to said destination containing a notification of the selected image output device; and  
transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 43. A program product comprising:  
a computer-readable medium; and  
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of:  
receiving E-mail addressed to a portable terminal unit;  
preparing receipt notice E-mail based on the received E-mail;  
transmitting said receipt notice E-mail to said portable terminal unit;

acquiring location information of said portable terminal unit;  
selecting one of multiple image output devices on the basis of the acquired location information of said portable terminal unit;  
sending an E-mail to said portable terminal unit containing a notification of the selected image output device; and  
transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 44. An E-mail controlling apparatus comprising:  
a communication interface for sending and receiving E-mails;  
a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.

Claim 45. The E-mail controlling apparatus of claim 44, wherein said at least one E-mail generated by the processor includes information on multiple prospective image output devices, and wherein, upon receipt of an E-mail from the certain destination, designating one of the multiple prospective image output devices, the processor sends said part of the E-mail to the designated image output device.

Claim 46. The E-mail controlling apparatus of claim 44, wherein the processor separately generates an E-mail containing said notification of the receipt

of the E-mail, and an E-mail containing information on at least one output device to which at least a part of the E-mail is to be outputted.

Claim 47. The e-mail controlling system of claim 15, wherein said selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device.